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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,350	10/29/2003	Tsuyoshi Uchara	021311B	5977

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ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP  
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WASHINGTON, DC 20006

EXAMINER

GREIMEL, JOCELYN

ART UNIT	PAPER NUMBER
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3693

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/695,350	Applicant(s) UEHARA ET AL.	
	Examiner Jocelyn Greimel	Art Unit 3693	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 7-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/06/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07 February 2007 has been entered.

### ***Status of Claims***

2. Claims 7, 8, 10, 13 and 14 are currently amended. Claims 1-6 have been canceled. Claims 15 and 16 have been added. Claims 7-16 are to be examined.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 7-11 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Gross (US Patent No. 6,721,716 B1).**

5. In reference to claims 7 and 13, Gross discloses a method, system and apparatus for managing transactions and settlements using:

- a. a supplier system used by a supplier who issues an invoice;
- b. a buyer system used by a buyer who receives the invoice;
- c. a finance system for managing a bank account of the supplier and a bank account of the buyer and for performing a deposit/withdrawal processing from the bank account of said buyer to the bank account of said supplier (at least col. 2, line 5+; col. 3, line 17 – col. 5, line 12); and
- d. a server which is connected communicably to the supplier system, buyer system and finance system through a communications network; wherein the method comprises the steps in which:
  1. the server receives, from said supplier system, an electronic invoice on which unique identification code for identifying said invoice and said unique identification code are generated by said supplier system;
  2. said server registers said received electronic invoice and a status thereof in a database;
  3. the server automatically creates a collection request telegraphic message for payment of the registered electronic invoice on the basis of said unique identification code on the registered

- electronic invoice, when approval is made by said buyer, and transmits the collection request telegraphic message to said finance system;
4. upon reception of the collection request telegraphic message, said finance system performs collection processing which involves transferring the invoice amount described in said electronic invoice from the bank account of the buyer to the bank account of the supplier, and when said collection processing is completed, said finance system transmits a collection completion notification to said server system; and
  5. said server, when receiving said collection completion notification, specifies, on the basis of said collection completion notification, an electronic invoice having the unique identification code of said electronic invoice, which is the basis for said collection request telegraphic message, from said database, updates the status of said specified electronic invoice registered in said database to paid status of said electronic invoice, and transmits the paid status of the electronic invoice to at least said supplier system of said supplier system and buyer system (col. 2, line 5+; col. 3, line 17 – col. 5, line 12; especially col. 7, line 37 – col. 10, line 5).

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6. In reference to claims 8 and 14, Gross discloses the method for managing transactions and settlements, further comprising:

- e. a factoring system which is a computer system wherein said supplier system transmits the electronic invoice received from said supplier system to said server;

- f. said server performs said (B) through (E) when receiving said electronic invoice from said factoring system in said (A), and, when receiving the invoice from said supplier system without using said factoring system in said (A), said server performs the following steps of (F) through (J):

- F. said server registers said received electronic invoice in a database;

- G. the server transmits, to said buyer system, a GUI screen for showing contents of said electronic invoice registered in said database and for allowing said buyer to approve the contents of said electronic invoice, and causes the buyer system to display the GUI screen;

- H. said server or buyer system automatically creates a transfer request telegraphic message having said unique identification code written on said registered electronic invoice, on the basis of said registered electronic invoice approved by said buyer, in response to that said buyer has approved the contents of said electronic invoice displayed on said GUI screen by said buyer

system, and then transmits the transfer request telegraphic message to said buyer finance system;

- I. upon reception of the transfer request telegraphic message having said unique identification code, said finance system performs the deposit/withdrawal processing for a transfer of the electronic invoice having said unique identification code; and
1. said supplier finance system transmits, to said server or supplier system, an electronic deposit/withdrawal detailed statement describing that a deposit is made to the bank account of said supplier, the electronic deposit/withdrawal detailed statement having said unique identification code, whereby said server or said supplier is enabled to specify which one is the paid electronic invoice, by means of said unique identification code possessed by the electronic deposit/withdrawal detailed statement which is received from said supplier finance system (col. 2, line 5+; *GUI discussion* col. 3, line 17 – col. 5, line 12; especially col. 7, line 37 – col. 10, line 5).

7. In reference to claim 9, wherein the supplier system searches using the unique code of the statement and reconciles the invoice (col. 4).

8. In reference to claim 10, wherein the finance server notifies the server of deposit/withdrawal and the server updates the status (col. 7 – col. 10).

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9. In reference to claim 11, wherein the server updates the status and causes the buyer system to display a GUI screen (col. 4).

10. In reference to claim 15, wherein the server manages the status of the invoice (col. 3, line 17 – col. 5, line 12; especially col. 7, line 37 – col. 10, line 5).

11. In reference to claim 16, wherein the manages the status of the invoice and notifies the supplier system, the buyer system and the finance system of the status using the unique code (col. 2, line 5+; *GUI discussion* col. 3, line 17 – col. 5, line 12; especially col. 7, line 37 – col. 10, line 5).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. **Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gross in view of Dent et al (US Patent No. 6,128,603, hereinafter Dent).** Gross



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discloses a method and system for managing transactions and settlements but does not disclose the GUI screen displaying a calendar. However, Gross discloses a system wherein the server pastes status marks on a GUI screen of the buyer system and changes marks depending on the changing status (col. 7, lines 56-67 – col. 8, lines 1-16 and figures 6-7). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the transaction and settlement system of Gross which includes GUI screens with the calendar GUI screen of Dent to display billing information because it would increase the ease of use for the user and make the display more user-friendly. It would be another clear way to present billing information to the user of the system which would decrease late payments.

### ***Response to Arguments***

15. Applicant's arguments with respect to claims 7-16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 10-13 of copending Application No. 10/694,269. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims define the same method, server system and computer program for managing transactions and

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settlements in an electronic banking setting. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached on Monday - Friday 8:30 AM - 4:30 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel  
Examiner, Art Unit 3693  
April 26, 2007

 4/30/07  
JAMES A. KRAMER  
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